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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,399	03/26/2004	Jerry Dale St. Clair	CH2975USNA	1346

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EXAMINER

MCDONOUGH, JAMES E

ART UNIT	PAPER NUMBER
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1755

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/810,399

Applicant(s)

CLAIR ET AL.

Examiner

J. Pasterczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 25-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to a condensation catalyst, classified in class 502, subclass 171.
- II. Claims 25-46, drawn to processes for making polyesters, classified in class 528, subclass various depending on the specifics of the catalyst and reactants.

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for using the product as claimed can be practiced with another materially different product, such as a prior art catalyst, e.g. an antimony catalyst.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Kathryn Sanchez, Esq., on 4/21/05, a provisional election was made with traverse to prosecute the invention of group I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The abstract of the disclosure is objected to because it is not consistent with the elected invention since it lacks all its limitations and hence is not fully descriptive. Correction is required. See MPEP § 608.01(b).

7. The use of the trademark TYZORTM with various suffixes has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

8. Claims 2, 6, 7, 16, 19 and 20 are objected to because of the following informalities: in claim 2, l. 4, there should be no commas after “methyl” or “dimethyl”, and in the last line correct the spelling to --tri-isopropanolamine--; likewise in claim 16. In claim 6 insert the indefinite article --a-- before “tris-” and “diphosphonite ester”; likewise in claim 19. In claim 7, l. 4, delete the comma before “tetrakis”; in l. 5 delete the first open parenthesis and correct the spelling to --triethylene glycol phosphate--; likewise in claim 20. Appropriate correction is required.

9. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the titanium species being a compound, does not reasonably provide enablement for the titanium species to be titanium metal. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly

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connected, to make or use the invention commensurate in scope with these claims. Claim 1 currently recites that (1) may be titanium or a titanium compound. However, the specification contains no description whatsoever of this ingredient being titanium metal in any form other than as a compound, hence the present claims are not considered enabled to the full claimed extent of this ingredient.

10. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-12, 18, 23 and 24 contain the trademark/trade names TYZOR with various suffixes. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe various titanate and zirconate compositions and, accordingly, the identification/description is indefinite. Deletion of the trademarks would correct these problems.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP §

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2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, in claims 2, 10-12, 19-21, 23 and 24 use the phrase "which is" between the broad recitation of an ingredient and the narrower descriptions of the ingredients. In claim 1, the first four lines recite that there is a complexing agent in the composition and that the complexing agent is an alkanolamine; the former is the broader term, the latter the narrower term.

In claims 7 and 20, it seems as if the name of the phosphorous acid can be recited in a more compact form, perhaps by writing out the formula.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-4, 9-12, 15-17, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Putzig, USP 6,166,170 (hereafter referred to as Putzig I).

Putzig I discloses the invention as claimed (abstract; col. 2, l. 44-64; col. 3, l. 9-19, l. 38-56; example 10 *inter alia*).

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13. Claims 1-4, 9-12, 15-17, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Duan et al., USP 6,489,433 (hereafter referred to as Duan).

Duan discloses the invention as claimed (abstract; col. 2, l. 42-62; col. 3, l. 5-38; col. 5, l. 28-52).


14. Claims 1, 2, 5 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Putzig et al., USP 6,066,714 (hereafter referred to as Putzig II).

Putzig II discloses the invention as claimed (abstract; col. 2, l. 22-48; col. 3, l. 37-63; examples 1-3, 5; control B).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


J. Pasterczyk

11/7/06


J. A. LORENGO
SUPERVISORY PATENT EXAMINER